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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,001	07/05/2001	Shinichi Matsushita	Q65191	1660

7590 08/03/2005

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EXAMINER	
LUU, LE HIEN	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/898,001	MATSUSHITA ET AL.	
	Examiner	Art Unit	
	Le H. Luu	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 7-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 7-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 7-22 are presented for examination.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner can not find anywhere in the specification that applicant disclosed "the analyzing unit decides whether to merge the electronic messages based on number of the electronic message".

4. The amendment filed on 02/18/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the analyzing unit decides whether to merge the electronic messages based on number of the electronic message" is not being disclosed in the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> or
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 7, 10, 14, 17, and 21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Allan et al. (Allan) Pub No. 2001/0048683.

7. As to claim 7, Allan teaches the invention as claimed, including a device that receives an electronic message from a source device and transmits the electronic message to a target device, comprising:

a receiving unit that receives an electronic message (page 3 para. [0029]);

a storing unit that stores electronic messages received by the receiving unit during a predetermined duration (page 3 para. [0032]);

an analyzing unit that analyzes a content of the electronic message and decides whether to merge the electronic messages stored in the storing unit into a merged electronic message before transmitting the electronic message to the target device (page 4 para. [0041]);

a merging unit that merges the electronic messages stored in the storing unit into the merged electronic message upon deciding at the analyzing unit to merge the electronic message (Figs 3-4; Abstract; page 4 para. [0037 – 0041]); and

a transmitting unit that transmits the merged electronic message to the target device (page 4 para. [0041]).

8. As to claim 10, Allan teaches the analyzing unit deletes the electronic message after the merging unit merges the electronic messages into the merge electronic message (page 5 para. [0047]).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 9, 11-13, 16, 18-20, and 22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Allan et al. (Allan) Pub No. 2001/0048683, in view of Kulakowski et al. (Kulakowski) patent no. 6,229,621.

11. As to claim 9, Allan teaches the invention substantially as claimed as discussed above. However, Allan does not explicitly teach deciding whether to merge the electronic message based on a length of each of the electronic messages.

Kulakowski teaches a message must be contained within a specified packet length transmitting (col. 7 lines 13-21; col. 14 line 66 – col. 15 line 11).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Allan and Kulakowski to decide whether to merge the electronic message based on a length of each of the electronic messages because it would format the packet to a proper packet size that can be handle by the network.

12. As to claim 11, Allan teaches the invention substantially as claimed as discussed above. However, Allan does not explicitly teach dividing the electronic message into a plurality of parts before transmitting.

Kulakowski teaches a message needs to be broken into parts due to its length before transmitting (col. 7 lines 13-21; col. 14 line 66 – col. 15 line 11).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Allan and Kulakowski to divide a lengthy electronic message into a plurality of parts before transmitting because it would format the packet to a proper packet size that can be handle by the network.

13. As to claim 12, Allan and Kulakowski teach the analyzing unit decides whether to divide the electronic message based on a length of the electronic message (Allan, page 5 para. [0047]; Kulakowski, col. 7 lines 13-21; col. 14 line 66 – col. 15 line 11).

14. As to claim 13, Allan and Kulakowski teach the analyzing unit deletes the electronic message after the dividing unit divides the electronic messages into the merge electronic message (Allan, page 5 para. [0047]; Kulakowski, col. 7 lines 13-21; col. 14 line 66 – col. 15 line 11).

15. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim "A computer product" raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Examiner suggests applicant replaces

"A computer product that implements" with "A computer readable medium containing executable instructions for implementing" to overcome the 35 U.S.C. 101 rejection.

17. Claims 14-22 have similar limitations as claims 7-13; therefore, they are rejected under the same rationale.

18. Applicant's arguments with respect to claims 7-22 have been considered but are deemed to be moot in view of the new grounds of rejection.

19. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu whose telephone number is 571-272-3884. The examiner can normally be reached on 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LE HIEN LUU
PRIMARY EXAMINER

July 25, 2005